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09/391,966

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RICHARD J. DITZIK

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27058

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08/12/2004

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EXAMINER

BHATTACHARYA, SAM

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 08/12/2004

41

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,966

Applicant(s)

DITZIK, RICHARD J.

Examiner

Sam Bhattacharya

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 54,56-58 and 60-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 54,56-58 and 60-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 56, 57 and 61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 56, the specification fails to provide support for a handset unit configured to a PDA. Nowhere does the specification disclose a handset configured to a PDA that communicates wirelessly with a base unit. The PDA is mentioned interchangeably with a notebook computer, not a handset.

Regarding claim 57, the specification fails to provide support for a handset unit configured to a cellular telephone unit. It is suggested that the claim be amended to recite "said handset unit is a cellular telephone unit."

Regarding claim 61, the specification fails to provide support for a handset unit configured to function as a hands-free speakerphone-like operation. The specification discloses a wireless earset that replaces the handset for hands-free applications.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 54, 56, 58, 60, 62, 64, 65, 68 and 69, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Babitch et al. (US 5,930,719).

Regarding claim 54, Babitch et al. discloses a method for handset unit communication, including transmitting data from a handset 12 via a wireless link 16 to a portable local communication base unit 18 a relatively short distance away, receiving data by the handset via the wireless link from the base unit, using the handset to communicate data selectively to and from the base unit, and communicating the data from the handset for computer use in the desktop computer 20 and for bi-directional communication over the wireless link. See Fig. 1 and col. 3, lines 16-30.

Regarding claim 56, Babitch et al. discloses that the handset is configured to a "palmtop" device, which can be a PDA. See col. 4, lines 17-21.

Regarding claim 58, it is inherent to system of Babitch et al. that the handset communicates with other handsets.

Regarding claims 60, Babitch et al. discloses that the handset accesses the internet via the base unit. See col. 4, lines 9-14.

Regarding claim 62 and 65, Babitch et al. discloses a method for handset unit communication, including communicating bi-directional wireless handset unit data for wireless data networking with a portable base unit 18, transmitting wireless RF data from the handset 12 to the base unit, receiving by the handset RF data from the base unit, and communicating the handset unit data to have the base unit relay the data to and from an external wide area network (the internet).

Claim 64 contains substantially the same limitations as claim 58 and is therefore rejected for the same reasons as claim 58.

Regarding claim 68, Babitch et al. discloses that the handset sends and receives e-mail via the external wide area network.

Regarding claim 69, Babitch et al. discloses that handset communicates voice and audio information. See col. 4, lines 29-34.

3. Claims 61 and 66, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Puthuff (US 6,112,103).

Regarding claims 61 and 66, Puthuff discloses a method for communication, including transmitting data from hands-free earphones 400 and 402 via a wireless link to a portable local communication base unit 100 a relatively short distance away, receiving data by the earphone via

Art Unit: 2685

the wireless link from the base unit, using the earphone to communicate data selectively to and from the base unit, and communicating the data from the earphone for computer use in the personal computer 308 and for bi-directional communication over the wireless link. See Fig. 2 and col. 3, lines 44-53.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 57 and 67, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Babitch et al. in view of Haartsen (US 5,699,367).

Regarding claims 57 and 67, Babitch et al. fails to disclose a handset that communicates wirelessly with a portable base station, where the handset is a cellular telephone.

However, Haartsen discloses a short-range RF link between a cellular telephone and a portable base unit, shown as a laptop computer. See Fig. 2 and col. 4, 25-29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method for handset unit communication of Babitch et al. by using a cellular telephone to communicate with a computer as taught by Haartsen to achieve a single handset that can be used to communicate with other cellular telephones as well as with a computer.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rossman (US 5,809,415) discloses a cellular telephone that connects to a corporate wide area network and the internet.

Kimball (US 5,953,322) discloses a cellular internet telephone that communicates wirelessly with a base station that is in turn connected to the internet.

Flint et al. (US 6,289,213) discloses a handset that communicates wirelessly with a base station that is connected to a computer.

Response to Arguments

7. Applicant's arguments with respect to claims 54, 56-58, 60-62 and 64-69 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendments to the claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2685


CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (703) 605-1171. The examiner can normally be reached on 8:30 a.m. to 5:00 p.m., Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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